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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,329	12/04/2000	Varghese John	00228-US-NEW3	8197
20350 7590 10/23/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER KAM, CHIH MIN	
			ART UNIT 1656	PAPER NUMBER
			MAIL DATE 10/23/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/730,329

Applicant(s)

JOHN ET AL.

Examiner

Chih-Min Kam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-10 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7, 10 and 22 is/are rejected.
- 7) ☒ Claim(s) 6-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The finality of previous Office Action dated July 17, 2007 is withdrawn due to a new ground of rejection.

#### ***Status of the Claims***

2. Claims 6-10 and 22 are pending.

Applicant's amendment filed October 9, 2007 is acknowledged, and applicants' response has been fully considered. Claim 6 has been amended. Therefore, claims 6-10 and 22 are examined.

#### **Withdrawn Claim Objections**

3. The previous objection to claims 6, 7, 10 and 22 is withdrawn in view of applicants' amendment to the claims, and applicants' response at page 4 in the amendment filed October 9, 2007.

#### **Withdrawn Claim Rejections - 35 USC § 112**

4. The previous rejection of claims 6, 8 and 9 under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicant's amendment of the claim, and applicant's response at page 4 of the amendment filed October 9, 2007.

#### ***Sequence Listing***

5. A paper copy and CRF of Sequence Listing filed April 26, 2007 is acknowledged and CRF has been entered. However, the amino acid sequence of SEQ ID NO: 94 is not consistent with the description in the Sequence Listing. For example, SEQ ID NO:94 is Xaa-Val-Met-Xaa-Val-Ala-Glu-Phe, but in the description (<223>) of position 3 indicates Xaa is Met, Phg, n-Leu, Asn, Phe, Gly or Val. SEQ ID NO: 96 has the amino acid sequence of Xaa-Val-Leu-Xaa-Val-

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Ala-Glu-Phe in the Sequence Listing, while SEQ ID NO:96 in claim 7 has n-Leu at position 3.

Applicants must comply with the requirements of the sequence rules (37 CFR 1.821-1.825) and provide a copy of sequence listing and CRF containing all the sequences. Appropriate correction is required.

### ***Claim Objection***

6. Claims 6-10 are objected to because of the use of the phrase “Y is statine, acha (cyclohexylmethylstatine) or phenylstatine (Phe-sta).”, while in the SEQ ID NO:93 of Sequence Listing, “Y is statine, acha or Phe-sta, wherein the phenyl group may optionally have mono or di-substitution chosen from the group consisting of Cl, F, Br, methyl and methoxyl”. Therefore, it is more consistent by adding the phrase “wherein the phenyl group of phenylstatine optionally has mono or di-substitution chosen from the group consisting of Cl, F, Br, methyl and methoxyl” to claims 6.

7. Claims 7 and 10 are objected to because the amino acid sequences cited in the claims have both three-letter code and one letter code in the same sequence. Use of all three letter codes for the amino acid sequence is suggested. For example, use of Ac-Val-Phg-Sta-Val-Ala-Glu-Phe (SEQ ID NO:95) instead of Ac-VPhgStaVAEF.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 7, 10 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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9. Claim 7 is indefinite because of the use of the term “R<sup>1</sup>-VMStaVAEF (SEQ ID NO:94)” R<sup>1</sup>-V n-Leu-Sta-VAEF (SEQ ID NO:96)” and “R<sup>1</sup>-V MPhe-staVAEF (SEQ ID NO:99)”. The terms cited render the claim indefinite, it is not clear what amino acid sequence the SEQ ID NO:94, 96 or 99 has, since in the Sequence Listing, SEQ ID NO:94 is Xaa-Val-Met-Xaa-Val-Ala-Glu-Phe, but in the description (<223>) of position 3 indicates Xaa is Met, Phg, n-Leu, Asn, Phe, Gly or Val; SEQ ID NO: 96 has the amino acid sequence of Xaa-Val-Leu-Xaa-Val-Ala-Glu-Phe instead of R<sup>1</sup>-V n-Leu-Sta-VAEF; and SEQ ID NO:99 has Met-Sta-Val-Ala-Glu-Phe (6 amino acids) instead of R<sup>1</sup>-V MPhe-staVAEF (7 amino acids).

10. Claim 10 is indefinite because of the use of the term “Ac-VMStaVAEF (SEQ ID NO:94)”. The term cited renders the claim indefinite, it is not clear what amino acid sequence the SEQ ID NO:94 has. It appears in the Sequence Listing, SEQ ID NO:100 has the amino acid sequence of Ac-VMStaVAEF, and SEQ ID NO:94 is Xaa-Val-Met-Xaa-Val-Ala-Glu-Phe.

11. Claim 22 recites the limitation “wherein the phenyl group of phenylstatine has mono or di-substitution chosen from the group consisting of Cl, F, Br, methyl and methoxyl” in lines 1-3. There is insufficient antecedent basis for this limitation in the claim. Addition of the term “wherein the phenyl group of phenylstatine optionally has mono or di-substitution chosen from the group consisting of Cl, F, Br, methyl and methoxyl” to claim 6 would resolve the issue.

### ***Conclusion***

12. Claims 7, 10 and 22 are rejected; and claims 6-10 are objected to.

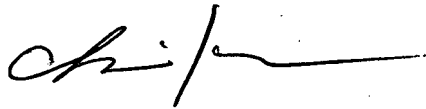
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Bragdon can be reached at 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.  
Primary Patent Examiner



**CHIH-MIN KAM**  
**PRIMARY EXAMINER**

CMK

October 22, 2007